

Application No. 10/024,570
Reply dated September 22, 2003
Response to Office Action dated May 20, 2003

REMARKS/ARGUMENT

Description of amendments

Claims 2-9 are now pending and under examination. Applicant has amended claims 2-4, 6 and 8, cancelled claim 1, and added claim 9. No new matter has been added.

New claim 9 is supported by the application as originally filed (see, for example, original claim 1 and paragraph 16).

Miscellaneous

In the Office Action, the Examiner requested confirmation that the copy of specification and drawings submitted with the Declaration on March 29, 2002, is a duplicate of that originally filed. In response, Applicant respectfully points out that the copy of specification and drawings was not a newly submitted copy to replace the originally filed copy. Instead, that copy was attached to the Declaration as required under MPEP §602 for the purpose of identifying the specification and drawings which the Declaration refers to.

Rejection under 35 U.S.C. §102

Claims 1-4 and 8 were rejected under 35 U.S.C. §102(b) as being anticipated by JP 11-033313. Claims 1-5 and 8 were rejected under 35 U.S.C. §102(b) as being anticipated by EP 1 031 367 A1. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections.

The cancellation of claim 1 renders the rejection of claim 1 moot.

Applicant respectfully submits that new independent claim 9 recites various patentable features that are not taught or suggested by the cited references. For example, the filter arrangement of claim 9 includes a first filter assembly that prevents fluid communication between an unfiltered side of the filter element and the return flow channel during operation. As a result, no unfiltered fluid can flow from the unfiltered side of the filter element into the return flow channel during operation. Only when the filter element is being removed, the first seal assembly opens the return flow channel to drain the unfiltered fluid.

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In the preferred embodiment shown in Figure 1, for example, this function may be accomplished by the seal 11 or by seals 11 and 12, which prevent fluid communication between the unfiltered side of the filter element and the return flow channel during operation.

JP 11-033313 does not teach or suggest this feature. In the filter of JP 11-033313, the bypass oilway (26) is always in fluid communication with the unfiltered side of the filter element (23) through the bypass element (28) during operation (see paragraphs 19 and 30, for example). This is consistent with the function of the bypass oilway (26), which is to allow the oil that is supplied during operation through the inlet (24) but is in excess of what is needed for engine lubrication to flow back to the oil pan (see paragraph 30, for example). Since JP 11-033313 does not teach or suggest this limitation of claim 9, it cannot anticipate claim 9 or claims 2-8 which depend from claim 9.

As stated above, the first filter assembly of claim 9 performs three functions. The first function is to enable the draining of unfiltered liquid into the return flow channel when the filter element is being removed. The second function is to reduce back flow of unfiltered liquid from the unfiltered side of the filter element into the inlet of the filter arrangement during operation. The third function is to seal the return flow channel during operation to prevent fluid communication between an unfiltered side of the filter element and the return flow channel.

EP 1 031 367 does not teach or suggest a seal assembly that performs all three functions. In particular, the filter shown in Figure 4 of EP 1 031 367 does not show a seal that performs all three functions. Accordingly, EP 1 031 367 cannot anticipate claim 9 or claims 2-8 which depend from claim 9.

Rejection under 35 U.S.C. §103(a)

Claims 6 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over EP 1 031 367 in view of JP 11-033313. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

The Office Action apparently acknowledged that neither EP 1 031 367 nor JP 11-033313 teaches or suggests a first seal that extends outwardly beyond a radial edge of the

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filter element. However, the Office Action stated that "[u]pon modification of '367 with the radial extension of '313 the seal 15 would extend radially beyond the filter to contact the housing...." Applicant respectfully disagrees, because the Office Action provides no support for the conclusion. There is no disclosure in the cited references, nor is it dictated by logic or necessity, that a radially extending seal must extend beyond the radial edge of the filter element. Since the cited references do not teach or suggest a first seal that extends outwardly beyond the radial edge of the filter element, they cannot render claim 6 or 7 obvious. MPEP §2143 (in order to establish a prima facie case of obviousness, the prior art references must teach or suggest all the claim limitations).

Additionally and alternatively, a person with ordinary skill in the art would not be motivated to extend a seal beyond the radial edge of the filter element to contact the inner side surface of the filter housing. If it does, such a seal would prevent the draining of unfiltered oil through the drainage opening (10) when the filter element is removed, because the seal would remain in contact with the inner side surface of the filter housing during the removal of the filter element.

Furthermore, Applicant disagrees with the Office Action's statement that "it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the radial extension of '313 on the seal 15 of '367, since '313 teaches the benefit of preventing return flow of unfiltered liquid when the engine is shut off." Applicant respectfully submits that the alleged benefit of "preventing return flow of unfiltered liquid when the engine is shut off" does not necessarily lead to having the radial extension of '313 on the seal 15 of '367. There is no reason why having the radial extension of '313 on the seal 15 of '367 is necessary to achieve the alleged benefit of preventing return flow of unfiltered liquid when the engine is shut off.

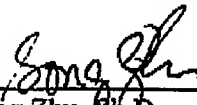
In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

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If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (CAM #: 037141.50786US).

Respectfully submitted,

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